



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

CD AFP

Application No. : 10/775,207  
Applicant : HUBBARD, MICHAEL  
Filed : FEBRUARY 11, 2004  
Title : FABRIC BACKED COVERING MEMBRANE WITH PRE-APPLIED  
ADHESIVE

Art Unit : 1773  
Examiner : ZIRKER, DANIEL R.

Atty Docket No. : OMNO-0003-UT1

Mail Stop Appeal Brief- Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The below-identified communication(s) is (are) submitted in the above-captioned application or proceeding:

- Appellant's Brief
- Patent Fee Transmittal
- Credit Card Payment Form (PTO-2038)
  
- The Commissioner is hereby authorized to charge payment of any fees associated with this communication, including fees under 37 C.F.R. §§ 1.16 and 1.17 or credit any overpayment to **Deposit Account Number 10-0233-OMNO-0003-UT1**.

Respectfully submitted,

  
\_\_\_\_\_  
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August 21, 2006

# Patent Fee Transmittal for FY 2006

Applicant(s) Claims Small Entity Status 37 C.F.R. 1.27

**TOTAL AMOUNT OF PAYMENT**

**\$500.00**

Application No. 10/775,207  
Filing Date 11-Feb-04  
Named Inventor Hubbard, Michael  
Examiner Name Zirker, Daniel R.  
Art Unit 1773  
Attorney Docket No. OMNO-0003-UT1



## FEE CALCULATION

### 1. Filing Fees

Application Type	Description	Large Entity		Small Entity	
		Code	(\$)	Code	(\$)
Utility	Basic	1011	300	2011	150
	Examination	1311	200	2311	100
	Search	1111	500	2111	250
Design	Basic	1012	200	2012	100
	Examination	1312	130	2312	65
	Search	1112	100	2112	50
Plant	Basic	1013	200	2013	100
	Examination	1313	160	2313	80
	Search	1113	300	2113	150
Reissue	Basic	1014	300	2014	150
	Examination	1114	600	2114	300
	Search	1314	500	2314	250
Provisional	Basic	1005	200	2005	100
National Stage	Basic	1631	300	2631	150
	Examination	1633	200	2633	100
	Search	1632	500	2632	250

### 2. Extra Claim Fee

#### a. Claims as Filed

	Extra Claims	Large Entity	Small Entity	
Total Claims	0	0	x	
Independent	0	0	x	
Multiple Dependent				

#### b. Claims as Amended

	After Amnt	Highest Paid	Present Extra	Large Entity	Small Entity	
Total Claims	20	20	*	0	x	
Independent	2	3	**	0	x	
First Presentation of Multiple Dependent						

\* Less than 20, enter 20 \*\* Less than 3, enter 3

### 3. Extra Page Fee

Total Pages	Extra Pages	Large Entity	Small Entity	
Code	(\$)	Code	(\$)	Paid
0	-100	0	x	1081 250 2081 125 \$ -

### Subtotal for Application Fees

1	\$	-	+	2	\$	-	+	3	\$	-	=	\$	-
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### 4. Additional Fees

Description	Large Entity		Small Entity		
	Code	(\$)	Code	(\$)	Paid
Extension for response first month	1251	120	2251	60	\$ -
Extension for response second month	1252	450	2252	225	\$ -
Extension for response third month	1253	1,020	2253	510	\$ -
Extension for response fourth month	1254	1,590	2254	795	\$ -
Extension for response fifth month	1255	2,160	2255	1,080	\$ -
Notice of Appeal	1401	500	2401	250	\$ -
Filing a Brief in Support of an Appeal	1402	500	2402	250	\$ 500
Request for Oral hearing	1403	1,000	2403	500	\$ -
Petitions under 1.17(f)	1462	400	1462	400	\$ -
Petitions under 1.17(g)	1463	200	1463	200	\$ -
Petitions under 1.17(h)	1464	130	1464	130	\$ -
Petition - public use proceeding	1451	1,510	1451	1,510	\$ -
Petition to Revive - Unavoidable	1452	500	2452	250	\$ -
Petition to Revive - Unintentional	1453	1,500	2453	750	\$ -
Utility Issue Fee	1501	1,400	2501	700	\$ -
Design Issue Fee	1502	800	2502	400	\$ -
Plant Issue Fee	1503	1,100	2503	550	\$ -
Reissue Issue Fee	1511	1,400	2511	700	\$ -
Publication Fee	1504	300	1504	300	\$ -
Statutory Disclaimer	1814	130	2814	65	\$ -

(cont.)

### Description (cont.)

	Code	(\$)	Code	(\$)	Paid
Recording each Assignment	8021	40	8021	40	\$ -
Submission of IDS	1806	180	1806	180	\$ -
Request for Cont. Examination (RCE)	1801	790	2801	395	\$ -
Filing Submission After Final	1809	790	2809	395	\$ -
Surcharge - late filing fee or oath	1051	130	2051	65	\$ -
Surcharge - late provisional fee	1052	50	2052	25	\$ -
Non-English Specification	1053	130	1053	130	\$ -
Processing Fee 37 CFR 1.17(q)	1807	50	1807	50	\$ -
Request for Ex Parte Reexamination	1812	2,520	1812	2,520	\$ -
Request Pub. of SIR prior to action	1804	920	1804	920	\$ -
Request Pub. of SIR after action	1805	1,840	1805	1,840	\$ -
Each Add. Invention Examined	1810	790	2810	395	\$ -
Expedited Examination (Design)	1802	900	1802	900	\$ -
Unintentionally Delayed Priority Claim	1453	1,370	1453	1,370	\$ -
Certificate of Correction	1811	100	1811	100	\$ -
Maintenance Fees 3.5 years	1551	900	2551	450	\$ -
Maintenance Fees 7.5 years	1552	2,300	2552	1,150	\$ -
Maintenance Fees 11.5 years	1553	3,800	2553	1,900	\$ -
Surcharge - Late Payment 6 mos.	1554	130	2554	65	\$ -
Other fee					\$ -

Additional Fee Subtotal 4 \$ 500

### METHOD OF PAYMENT (Check all that apply)

Credit Card (Provide credit card information and authorization on PTO-2038)  
 Deposit Account No. 10-0233-OMNO-0003-UT1

For the above-identified deposit account, the Director is hereby authorized to:

To charge the above-identified fee.  
 To charge any additional fees which may be required under 37 CFR 1.16, 1.17, 1.18, 1.20 and 1.492 or credit any overpayment to the deposit account number listed above.

Submitted by:

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August 21, 2006

Signature

Date



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No. : 10/775,207  
Applicant : HUBBARD, MICHAEL  
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ADHESIVE  
  
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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANT'S BRIEF**

Sir:

This is an appeal of Claims 1-20 currently pending in the present application that were rejected by the Examiner in a Final Office Action dated March 13, 2006 (Final Office Action). A Notice of Appeal and Request for Pre-Appeal Brief Review (Request) was timely submitted by Appellant to the Patent and Trademark Office on June 13, 2006. A Notice of Panel Decision from the Pre-Appeal Brief Review (Decision) was mailed on July 20, 2006, resetting the due date for filing of Appellant's Brief to August 21, 2006 (due to August 20, 2006 falling on a Sunday). Appellant is timely submitting the present Appellant's Brief to the Board of Appeals and Patent Interferences (Board) by: (1) submitting Appellant's Brief within one-month of the date set forth in the Decision; and (2) paying the appropriate fee.

**REAL PARTY IN INTEREST**

The real party in interest is OMNOVA Solutions, Inc., the assignee of the present application.

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### **RELATED APPEALS AND INTERFERENCES**

There are currently no appeals or interferences known to Appellant, Appellant's legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **STATUS OF CLAIMS**

Claims 1-20 are currently pending and are the only rejected claims on appeal. A clean copy of Claims 1-20 on appeal appears in the attached Claims Appendix.

### **STATUS OF AMENDMENTS**

On May 12, 2006, Appellant filed an amendment after final rejection pursuant to 37 CFR 1.116(b) that amended Claim 12 in response to the Final Office Action. This amendment was entered by the Examiner and resulted in the rejection of Claim 12, under 35 U.S.C. § 112, second paragraph being withdrawn in the May 24, 2006 Advisory Action (Advisory Action). All other rejections of the claims were maintained in the Advisory Action (see Advisory Action, p. 2). The attached Claims Appendix reflects Claims 1-20 as recited in the amendment after final rejection.

### **SUMMARY OF THE INVENTION**

In one embodiment, Appellant's claimed invention relates to a covering product (e.g., 112/312) comprising a membrane (e.g., 114/314) comprised of a thermoplastic, a fabric layer (e.g., 116/316) comprised of a fabric material attached to a lower side of the membrane 114/314 and an adhesive (e.g., 118/318) covering at least a portion of a lower side of the fabric layer 116/316 for allowing the covering product 112/312 to be adhered to a building structure 240. The adhesive 118/318 is pre-applied to the fabric layer 116/316 prior to adhering the covering product 112/312 on the building structure (See Claim 1; the specification at page 2, lines 8-12, page 6, lines 17-21, and page 7, lines 4-9; and FIGS. 1 and 3.).

The building structure may be a roof deck 240. (See Claim 2; the specification at page 3, lines 12-15; page 4, lines 24-28; page 4, line 29 to page 5, line 2; page 6,

lines 28-30; and FIG. 2). The lower side of the membrane (e.g., 114/214) may include an exposed section (e.g., 122/222) that is not covered by the fabric layer (e.g., 116/216) (see Claim 3; the specification at page 6, lines 20-21 and 25-26; and FIGS. 1-2.). The adhesive (e.g., 118) may comprise a styrene-ethylene-butylene styrene adhesive (see Claim 4; and the specification at page 8, lines 15-22). The covering product (e.g., 112/312) may include a release liner covering (e.g., 120/320) on the lower side of the fabric layer (e.g., 116/316) at least in the region where the adhesive (e.g., 118/318) is present (see Claim 5; the specification at page 6, lines 18-20 and at page 7, lines 6-7; and FIGS. 1 and 3) and possibly substantially all of a lower side of the covering product (e.g., 512) as shown by release liner 520 (see Claim 6; the specification at page 7, lines 28-30; and FIG. 5).

The thermoplastic may comprise polyvinyl chloride (see Claim 7; and the specification at page 5, lines 5-7). The fabric layer (e.g., 116) may be comprised of a non-woven fabric material (see Claim 8; and the specification at page 9, lines 4-6). The membrane (e.g., 114) may include a UV absorber and/or a UV screener (see Claim 9; and the specification at page 5, lines 7-9 and page 5, line 24 to page 6, line 2) and/or a fire retardant (see Claim 10; and the specification at page 5, lines 7-9).

In another embodiment, the Appellant's claimed invention comprises a method for mounting at least one membrane (e.g., 214/414) on a building structure comprising the following steps: (a) providing a building structure; and (b) adhering a first membrane 214/414 on the building structure. The first membrane 214/414 is adhered to the building structure by a first adhesive (e.g., 218/418) coated on a lower side of a first fabric layer (e.g., 216/416) bonded to the first membrane 214/414. The first fabric layer 216/416 is comprised of a first fabric material and the first membrane 214/414 is comprised of a thermoplastic. The first adhesive 218/418 is pre-applied to the first fabric layer 216/416 prior to adhering said first membrane 214/414 on the building structure (see Claim 11; the specification at page 2, lines 8-12, page 6, line 22 to page 7, line 3, and page 7, lines 10-25; and FIGS. 2 and 4). The method of this embodiment may include further steps. For example, a second membrane 252 may be adhered on the building structure by a second adhesive 248 coated on a lower side of a second fabric layer 250 comprised of a second fabric material bonded to the second

membrane 252. An exposed section 258 of the second membrane 252 may be overlapped over an overlapped section 244 of an upper side of the first membrane 214 with the exposed section 252 uncovered by the second fabric layer 250. When employing such additional steps in the method, the second membrane 252 is comprised of thermoplastic and the second adhesive 248 is pre-applied to the second fabric layer 250 prior to adhering the second membrane 252 on the building structure (see Claim 12 and the specification at page 6, line 22 to page 7, line 3; and FIG. 2). The exposed section 222 may be hot air welded to the overlapped section 258 (see Claim 12 and the specification at page 7, lines 2-3). A release liner covering the first adhesive 218 may be removed from the first adhesive 216 prior to adhering the first membrane 214 on the building structure (*e.g.*, roof substrate 240) (see Claim 16; and the specification at page 6, lines 19-20 and 28-30; and FIG. 2).

The method may be used where the building structure is a roof deck (*e.g.*, roof substrate 240) (see Claim 14; the specification at page 3, lines 12-15; page 4, lines 24-28; page 4, line 29 to page 5, line 2; page 6, lines 28-30; and roof substrate 240 of FIG. 2). The first adhesive 218 may be comprised of a styrene-ethylene-butylene styrene adhesive (see Claim 15; and the specification at page 8, lines 15-22). The thermoplastic may be comprised of polyvinyl chloride (see Claim 17; and the specification at page 5, lines 5-7). The first fabric material may be comprised of a non-woven material (see Claim 18; and the specification at page 9, lines 4-6). The first membrane 214 may include a UV absorber and/or a UV screener (see Claim 19; and the specification at page 5, lines 7-9 and page 5, line 24 to page 6, line 2) and/or a fire retardant (see Claim 20; and the specification at page 5, lines 7-9).

## **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

There are two grounds of rejection to be reviewed on this appeal:

- A. The first ground of rejection is whether Claims 1-20 comply with 35 U.S.C. § 112, second paragraph.
- B. The second ground of rejection is whether Claims 1-20 are unpatentable under 35 U.S.C. § 103(a) over either U.S. Patent No. 5,456,785 to Venable (Venable '785) or U.S. Patent No. 4,996,812 to Venable (Venable '812), each taken in view of International Patent No. WO98/56866 (WO' 866).

## **ARGUMENT**

### **A. REJECTION OF CLAIMS 1-20 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

In rejecting Claims 1-20 under 35 U.S.C. § 112, second paragraph, the Examiner has erred in the Final Office Action by failing to provide a proper basis for this rejection. Appellant must also respectfully but strenuously object to the Final Office Action's characterization of Claims 1-20 as being in "extremely poor condition" (see Final Office Action, p. 2). In fact, the Final Office Action provides no proper basis in support of this blatant mischaracterization of Claims 1-20 which are in full compliance with 35 U.S.C. § 112, second paragraph.

As set forth by the Manual of Patent Examining Procedure (MPEP) at § 2171, there are two separate requirements of 35 U.S.C. § 112, second paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

The Final Office Action provides no explanation as to why the term "covering product" fails to comply with the requirements of 35 U.S.C. 35 U.S.C. § 112. Similarly, the Final Office Action provides no explanation as to why the phrases "a

membrane comprising a thermoplastic" and "said fabric layer being comprised of a fabric material" in Claims 1 and 11 fail to comply with the requirements of 35 U.S.C. 35 U.S.C. § 112, second paragraph.

The following comments in the Final Office Action also indicate that this rejection 35 U.S.C. § 112, second paragraph is based on a misunderstanding of Appellant's claimed invention:

... and the apparent method of contemplated use in the last two lines of article claim 1 seems unnecessary; i.e. does applicant ever envision any embodiments where the product would be sold after its added on adhesive surface was adhered to a building" (Final Office Action, p. 2).

As one skilled in this art reading Appellant's application would understand, Appellant's claimed invention involves an adhesive that is *pre-applied* to the fabric layer. In other words, the adhesive is contacted with the fabric layer *before* the covering product is adhered to a building structure. This claimed feature distinguishes Appellant's claimed invention from a covering product that does not have an adhesive applied to its fabric layer prior to adhering the covering product to a building structure. For example, an adhesive might be spread on a building structure to allow a covering product including a fabric layer to be adhered to the building structure. In such a hypothetical covering product, the adhesive would *not be considered to be pre-applied to the fabric layer*. Also, as is understood in the field of commercial roofing, "pre-applied" typically refers to something being applied during the manufacture of the product as opposed to in the field. For example, U.S. Patent No. 6,080,458 to Russell *et al.* (see col. 3, lines 34-37 and col. 5, lines 37-40), cited by Appellant during the prosecution of the present application, describes a walkway pad for a roofing membrane where an adhesive tape is pre-applied to the lower surface of the pad during manufacture.

For at least the above reasons, the rejection of Claims 1-20 under 35 U.S.C. § 112, second paragraph, is *prima facie* improper and should be withdrawn.

**B. REJECTION OF CLAIMS 1-20 UNDER 35 U.S.C. § 103(A) AS UNPATENTABLE  
OVER VENABLE '785 OR VENABLE '812, EACH TAKEN IN VIEW OF WO' 866**

In rejecting Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over either Venable '785 or Venable '812, each taken in view of WO' 866, the Examiner has erred in the Final Office Action for at least the following four reasons: (1) the Examiner has failed to provide an Affidavit under 37 CFR § 104(d)(2) that was properly requested in Appellant's December 29, 2005 Amendment (Appellant's December Amendment); (2) the Examiner has failed to provide an Affidavit under 37 CFR § 104(d)(2) that was properly requested in Appellant's May 12, 2006 Amendment after Final (Appellant's Amendment After Final); (3) the Final Office Action fails to fully address the deficiencies of the Non-Final Office Action that were identified by Appellant and were discussed in detail in Appellant's December Amendment; and (4) the rejection of Claims 1-20 under 35 U.S.C. § 103(a) as unpatentable over either Venable '785 or Venable '812, each taken in view of WO '866, is *prima facie* improper.

**1. The Examiner has failed to comply with 37 CFR § 1.104(d)(2) in  
providing an Affidavit/Declaration in response to the request in  
Appellant's December Amendment.**

In the September 30, 2005 Non-Final Office Action (Non-Final Office Action), the Examiner rejected Claims 1-20, despite failing to: (a) identify where various claimed features were taught or suggested by the cited references; and (b) provide proper motivation for combining the references. In responding to the Non-Final Office Action (see Appellant's December Amendment, Section F, pp. 20-22), Appellant properly requested the Examiner to supply an Affidavit/Declaration under 37 CFR § 1.104(d)(2) to provide the factual bases upon which the Examiner relied in rejecting Claims 1-20 over the combination of Venable '785 or Venable '812, each taken in view of WO '866. To date, the Examiner has failed to provide the Appellant with the requested Affidavit/Declaration.

In the Advisory Action, the Examiner alleged that "after carefully reviewing

the two earlier prior art rejection paragraphs of record based on the Venable references he can only state that he has simply no idea of what personal knowledge applicant is referring to.” But to the contrary, Appellant’s December Amendment specifically discussed in Sections E(1)(a)(ii) and E(1)(b)(ii) why the Examiner’s alleged grounds for rejecting Claims 1-20 over Venable ‘785 was based on facts within the personal knowledge of the Examiner (see Appellant’s December Amendment, Sections E(1)(a)(ii), E(1)(b)(ii) and (F)). Appellant’s December Amendment also specifically discussed in Section E(4) why the Examiner’s alleged motivation for combining WO ‘866 with Venable ‘785 and/or Venable ‘812 was based on facts within the personal knowledge of the Examiner (see Appellant’s December Amendment, Sections E(4) and (F)). Therefore, and contrary to what the Examiner implies in the Advisory Action, Appellant’s December Amendment clearly identifies the facts within the personal knowledge of the Examiner that were the subject of Appellant’s proper request for an Affidavit/Declaration under 37 CFR § 1.104(d)(2).

Because the Examiner has failed to provide Appellant with a properly requested Affidavit/Declaration, under 37 CFR § 1.104(d)(2), the rejection of Claims 1-20 over the combination of combination of Venable ‘785 or Venable ‘812 in view of WO ‘866 is *prima facie* improper and should be withdrawn. At the very least, the Board is respectfully requested to give absolutely no weight to this completely unsupported speculation by the Examiner.

Appellant also points out that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the PTO argued “the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] expressly entitle an applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner’s asserted level of skill in the art].” Furthermore, in *In re Sun*, the Federal Circuit, held that “this procedure, so readily available, helps save the lack of citation in an office action from possible constitutional infirmity in denying reasonable notice and hence due process,” see 31 USPQ2d at 1455. Accordingly, the Examiner’s failure to comply with 37 CFR § 1.104(d)(2) has also denied the Appellant’s statutory rights under the Administrative Procedures Act, as well as the

Appellant's Constitutional rights under the Fifth Amendment, to reasonable notice and due process. Therefore, in view of *In re Sun*, the rejection of Claims 1-20 as unpatentable over the combination of combination of Venable '785 or Venable '812 in view of WO '866 is *prima facie* improper and should be withdrawn.

**2. The Examiner Has Failed to Comply with 37 CFR § 1.104(d)(2) in Providing an Affidavit/Declaration in Response to the Request in Appellant's After Final Amendment.**

In the Final Office Action, the Examiner rejected Claims 1-20, despite failing to identify where various claimed features were taught or suggested by the cited references. In responding to the Final Office Action, (see Appellant's After Final Amendment, Section I, pp. 20-22), Appellant properly requested the Examiner to supply an Affidavit/Declaration under 37 CFR § 1.104(d)(2) to provide the factual bases upon which the Examiner relied in rejecting Claims 1-20 over the combination of Venable '785 or '812 in view of WO '866. To date, the Examiner has failed to provide the Appellant with the requested Affidavit/Declaration. Also, the Examiner's comments in the Advisory Action fail to address Appellant's comments in Section I of Appellant's After Final Amendment.

Because the Examiner has failed to provide Appellant with a properly requested Affidavit/Declaration, under 37 CFR § 1.104(d)(2) in Appellant's December Amendment, the rejection of Claims 1-20 over the combination of Venable '785 or '812 in view of WO '866 is *prima facie* improper and should be withdrawn.

Also, for at least the reasons discussed above in Section B(1) of the present Appeal Brief, the Examiner's failure to comply with 37 CFR § 1.104(d)(2) has also denied the Appellant's statutory rights under the Administrative Procedures Act, as well as the Appellant's Constitutional rights under the Fifth Amendment, to reasonable notice and due process. Therefore, for this additional reason, the rejection of Claims 1-20 over the combination of combination of Venable '785 or Venable '812 in view of WO '866 is *prima facie* improper and should be withdrawn.

3. **The Final Office Action Has Failed to Fully Address the Deficiencies of the Non-Final Office Action that were Identified by Appellant and Discussed in Detail in Appellant's December Amendment.**

a. **The Final Office Action does not identify as incorrect a single specific detailed argument made by Appellant about the deficiencies of the rejection of Claims 1-20 under 35 U.S.C. 103(a) and references relied on for this rejection in Appellant's December Amendment.**

As noted in Sections D and E of Appellant's Amendment After Final, Appellant identified numerous specific deficiencies in the rejection of Claims 1-20 under 35 U.S.C. § 103(a) over the combination Venable '785 or '812 in view of WO '866 and discussed these deficiencies in detail in Section E of Appellant's December Amendment. Nevertheless, the Final Office Action only cursorily addresses the arguments made in Section E of the December Amendment. In fact, the Final Office Action does not identify as incorrect a single specific detailed argument made by Appellant about the deficiencies of this rejection and these references in Appellant's December Amendment.

b. **The Final Office Action also makes additional new arguments that are unsupported by what the cited references teach and/or suggest.**

The Final Office Action also makes additional new arguments that are unsupported by what the cited references teach and/or suggest. For example, the Final Office Action's newly alleged "motivation" for combining the references as set forth Section 3 is based merely on what the "Examiner . . . believes" and not on what the references actually teach and/or suggest. Furthermore, the Final Office Action continues to fail to cite actual text in the cited references that teach or suggest the

Final Office Action's alleged "motivation" for combining the cited references. Therefore, the alleged "motivation" to combine the references set forth in Section 3 of the Final Office Action is insufficient in view of relevant Federal Circuit precedent such as *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), cited in Appellant's December Amendment, which requires that *specific reasons* must be shown in the art for suggesting a combination of references.

c. The arguments set forth in Appellant's December Amendment have not been rebutted, and, therefore, the rejection of Claims 1-20 under 35 U.S.C. § 103(a) is *prima facie* improper and should be withdrawn.

For at least the above reasons, the arguments in Section E of Appellant's December Amendment have not been rebutted in the Final Office Action. Therefore, the rejections of Claims 1-20 under 35 U.S.C. § 103(a) set forth in the Non-Final Office Action and as repeated by the Final Office Action are *prima facie* improper for at least the reasons set forth in Section E of Appellant's December Amendment, and should be withdrawn.

4. The Rejection of Claims 1-20 under 35 U.S.C. § 103(a) as Being Unpatentable Over Either Venable '785 or Venable '812, Each Taken in View WO '866, is *Prima Facie* Improper.

At Section 3, the Final Office Action rejects Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Venable '785 or Venable '812, each taken in view of WO' 866 "*substantially for the same reasons set forth in Paragraph No. 8 of Paper No. 092705*" [the Non-Final Office Action] (emphasis added). However, the rejection of Claims 1-20 set forth in both the Final Office Action is *prima facie* improper for at least the reasons discussed below.

- a. **The Rejection of Claims 1-10 over Venable '785 in View of WO '866 is *Prima Facie Improper*.**
  
- i. **Requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2).**

As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obvious[ness] . . . The prior art reference (or references) when combined must teach or suggest *all of the claim limitations*” (Emphasis added). As also set forth in 37 C.F.R. § 1.104(c)(2), “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The *pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.*” (Emphasis added).

For at least the following reasons, the rejection of claims 1-10 over Venable '785 has failed to comply requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2).

- ii. **The Rejection of Claims 1-10 over Venable '785 in view of WO '866 is *Prima Facie Improper* for failing to comply with 37 C.F.R. § 1.104(c)(2).**

Claim 1 claims a covering product including the features of “a fabric layer attached to a lower side of [a] membrane [comprising a thermoplastic] . . . and an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure.” Claims 2-10 depend from Claim 1, either directly or indirectly, and, accordingly, also include the above claimed features.

In rejecting Claims 1-10 over Venable '785, the Final Office Action relies on the following conclusory statements from the Non-Final Office Action:

### **First Conclusory Statement**

The primary references each disclose (note particularly Venable '785, the Abstract, Col. 1, lines 9-15, lines 40-53, Col 2, lines 26-43, col. 3, lines 4-15; Venable '812, Col 1, liens 7-24, line 47-Col 2, line 17) substantial anticipations of at least the broad article and method claims except that the '785 patent utilizes a strip of double side adhesive tape for the outer adhesive layer covering the fabric, while the '812 patent has a fabric layer, i.e. matting, at least partially embedded in the adhesive (Col. 1, lines 18-20) before becoming solidified. (see Non-Final Office Action, pp. 3-4).

### **Second Conclusory Statement**

However, these limitations are believed to be, if not anticipatory elements of applicant's claims, teachings that are sufficient to put the claimed embodiments within the ordinary skill of the art." (see Non-Final Office Action, p. 4).

The First Conclusory Statement fails to properly to identify any text in Venable '785, that teaches or suggests the claimed features of "a fabric layer attached to a lower side of membrane [comprising a thermoplastic] . . . and an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure." The Second Conclusory Statement fails to cite any support for its allegation and does not explain how Venable '785 teaches or suggests any feature of Claims 1-10, much less the claimed features of "a fabric layer attached to a lower side of [a] membrane [comprising a thermoplastic] . . . and an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure."

For at least the above reasons and contrary to the requirements of 37 C.F.R. § 1.104(c)(2), the Non-Final Office Action never properly explains the "pertinence" of Venable '785 to Claims 1-10. Also, contrary to contrary to the requirements of 37 C.F.R. § 1.104(c)(2), the Final Office Action also fails to explain: (1) the pertinence of Venable '785 to Claims 1-10; and (2) how Venable '785 teaches or suggests any

feature of Claims 1-10. Therefore, the rejection of Claims 1-10 over Venable '785 in view of WO '866 is *prima facie* improper.

iii. **The Rejection of Claims 1-10 over Venable '785 in view of WO '866 is *Prima Facie* Improper for failing to comply with MPEP § 706.02(j).**

Venable '785 also does not teach or suggest the claimed feature of “a fabric layer attached to a lower side of [a] membrane [comprising a thermoplastic] . . . and an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure.” For example, the “strip of double sided adhesive tape” discussed in the First Conclusory Statement quoted above does not: (1) cover at least a portion of a fabric layer nor (2) allow a covering product to be adhered to a roofing structure. As described in Venable '785:

The matting [Venable 785's alleged fabric material] and polymeric film are somewhat narrower than the rubber or thermoplastic sheet [membrane comprising a thermoplastic], thus leaving an *exposed selvedge of rubber on both longitudinal edges of the underside of the roofing material*. A strip of double sided tape and/or primer is optionally applied to one of these selvedges as the composite material is cooling to provide a convenient way for adjacent *sheets of roofing to be attached to each other* (see Venable, Col. 2, lines 36-43, emphasis added).

Based on the above description in Venable '785, the double sided tape is applied directly to a thermoplastic membrane, not to a fabric material, and is used to adhere sheets of roofing material to each other and not to a building structure. WO '866 also does not teach or suggest the claimed feature of an adhesive applied to a fabric material attached to a membrane to allow the fabric material and membrane to be adhered to a building structure. Therefore, WO '866 cannot remedy the deficiencies of Venable '785. Accordingly, the rejection of Claims 1-10 over Venable '785 in view of WO '866 does not meet the requirements of MPEP § 706.02(j) and is, therefore, *prima facie* improper for this additional reason.

b. **Rejection of Claims 11-20 over Venable '785 is *prima facie* improper.**

i. **Requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2).**

The requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2) are set forth above in Section B(4)(a)(i).

ii. **The Rejection of Claims 11-20 over Venable '785 in view of WO '866 is *Prima Facie Improper* for failing to comply with 37 C.F.R. § 1.104(c)(2).**

Claim 11 claims the feature of mounting at least one membrane on a building structure the features of adhering a first membrane on the building structure, wherein the first membrane is adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane. Claims 12-20 depend from Claim 11, either directly or indirectly, and, accordingly, also include the above claimed features.

In rejecting Claims 11-20 over Venable '785, the Final Office Action relies on the First and Second Conclusory Statements quoted in Section B(4)(a)(ii) above. The First Conclusory Statement fails to properly to identify any text in Venable '785, that teaches or suggests the claimed features of adhering a first membrane on the building structure, wherein the first membrane is adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane. The Second Conclusory Statement fails to cite any support for its allegation and does not explain how Venable '785 teaches or suggest any feature of Claims 11-20, much less the claimed features of adhering a first membrane on the building structure, wherein the first membrane is adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane.

For at least the above reasons and contrary to the requirements of 37 C.F.R. § 1.104(c)(2), the Non-Final Office Action never properly explains the “pertinence” of Venable ‘785 to Claims 11-20. Also, contrary to contrary to the requirements of 37 C.F.R. § 1.104(c)(2), the Final Office Action also fails to explain: (1) the pertinence of Venable ‘785 to Claims 11-20; and (2) how Venable ‘785 teaches or suggests any feature of Claims 11-20. Therefore, the rejection of Claims 11-20 over Venable ‘785 in view of WO ‘866 is *prima facie* improper.

iii. **The Rejection of Claims 11-20 over Venable ‘785 in view of WO ‘866 is *Prima Facie* Improper for failing to comply with MPEP § 706.02(j).**

Venable ‘785 also does not teach or suggest the claimed features of adhering a first thermoplastic membrane on the building structure, wherein the first thermoplastic membrane is adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane. For example, the “strip of double sided adhesive tape” discussed in the First Conclusory Statement quoted above does not: (1) cover at least a portion of a fabric layer nor (2) allow a covering product to be adhered to a roofing structure. As described in Venable ‘785:

The matting [Venable 785’s alleged fabric material] and polymeric film are somewhat narrower than the rubber or thermoplastic sheet [membrane comprising a thermoplastic], thus leaving an *exposed selvedge of rubber on both longitudinal edges of the underside of the roofing material*. A strip of double sided tape and/or primer is optionally applied to one of these selvedges as the composite material is cooling to provide a convenient way for adjacent *sheets of roofing to be attached to each other* (see Venable, Col. 2, lines 36-43, emphasis added).

Based on the above description in Venable ‘785, the double sided tape is applied directly to a thermoplastic membrane and is used to adhere sheets of roofing material to each other and not to a building structure. WO ‘866 also does not teach or suggest

the claimed feature of adhering a membrane to a building structure by an adhesive coated on a lower side of a fabric layer bonded to the membrane. Therefore, WO' 866 cannot remedy the deficiencies of Venable '785. Accordingly, the rejection of Claims 11-20 over Venable '785 in view of WO '866 does not meet the requirements of MPEP § 706.02(j) and, therefore, the rejection of Claims 11-20 over Venable '785 is *prima facie* improper for this additional reason.

c. **The rejection of Claims 1-20 over Venable '785 in view of WO '866 should be withdrawn because it is *prima facie* improper.**

In summary, and for at least the reasons discussed above in Sections B(4)(a) and B(4)(b), the rejection of Claims 1-20 over Venable '785 in view of WO '866 is *prima facie* improper and should be withdrawn.

d. **The Rejection of Claims 1-10 over Venable '785 in View of WO '866 is *Prima Facie Improper.***

i. **Requirements of MPEP § 706.02(j).**

The requirements of MPEP § 706.02(j) are set forth above in Section B(4)(a)(i).

ii. **The Rejection of Claims 1-10 over Venable '812 in view of "WO '866 is *Prima Facie Improper.***

Claim 1 as claims a covering product that includes an adhesive on a fabric layer for adhering the covering product on a building structure, wherein the adhesive is pre-applied to the fabric layer prior to adhering the covering product on the building structure. But Venable '812 only describes pressing a "membrane 18" including "upper flexible EPDM rubber layer 20 together with a non-woven polyester fleece

like layer [fabric layer] 22 secured to the underside of the rubber layer" into an adhesive 15 on top of a metal decking 12 and a layer of insulated foam 14 (see Col. 2, lines 33-36 and Col. 3, lines 3-4 and 15-27). As can be see in Venable '812, Venable '812 describes applying an adhesive to a building structure (the substrate comprising the layer of insulated foam 14 and metal decking 12) to which the fabric layer is adhered. There is no teaching or suggestion in Venable '812 of the feature of using an adhesive that is pre-applied to a fabric layer of a covering product *prior* to adhering the covering product to a building structure as claimed by Claim 1. WO '866 also does not teach or suggest the claimed feature of using an adhesive that is pre-applied to a fabric layer of a covering product *prior* to adhering the covering product to a building structure. Therefore, the combination of WO '866 with Venable '812 does not teach or suggest all of the features of Claim 1 as required by MPEP § 706.02(j). Claims 2-10 depend from Claim 1, either directly or indirectly, and, accordingly, also include the patentable features of Claim 1 which are not taught or suggested by the combination of WO '866 with Venable '812.

iii. The Rejection of Claims 11-20 over Venable '812 in view of "WO '866 is *Prima Facie Improper*.

Claim 11 claims a membrane that is adhered to a building structure by an adhesive coated on a lower side of a fabric layer bonded to the membrane, wherein the adhesive is pre-applied to the first fabric layer prior to adhering the membrane on the building structure. But Venable '812 only describes pressing a "membrane 18" including "upper flexible EPDM rubber layer 20 together with a non-woven polyester fleece like layer [fabric layer] 22 secured to the underside of the rubber layer" into an adhesive 15 on top of a metal decking 12 and a layer of insulated foam 14 (see Col. 2, lines 33-36 and Col. 3, lines 3-4 and 15-27). As can be see in Venable '812, Venable '812 describes applying an adhesive to a building structure (the substrate comprising the layer of insulated foam 14 and metal decking 12) to which the fabric layer is adhered. There is no teaching or suggestion in Venable '812 of using an adhesive that is pre-applied to a fabric layer bonded to a membrane *prior* to adhering the membrane

to a building structure as claimed by Claim 11. WO '866 also does not teach or suggest the claimed feature of using an adhesive that is pre-applied to a fabric layer of a covering product *prior* to adhering the covering product to a building structure. Therefore, the combination of WO '866 with Venable '812 does not teach or suggest all of the features of Claim 11 as required by MPEP § 706.02(j). Claims 12-20 depend from Claim 11, either directly or indirectly, and, accordingly, also include the patentable features of Claim 11 which are not taught or suggested by the combination of WO '866 with Venable '812.

iv. The rejection of Claims 1-20 over Venable '812 in view of WO '866 should be withdrawn because it is *prima facie* improper.

In summary, and for at least the reasons discussed above in Sections B(4)(d)(ii) and B(4)(d)(iii), the rejection of Claims 1-20 over Venable '812 in view of WO '866 is *prima facie* improper and should be withdrawn.

e. The Combination of WO '866 with Venable '785 or Venable '812, is *Prima Facie* Improper.

i. Final Office Action and Non-Final Office Action fail to provide appropriate basis for combining WO '866 with Venable '785 or Venable '812.

The rejection of Claims 1-20 over Venable '785 or Venable '812, in view of WO '866 as set forth in the Non-Final Office Action, which is also relied on by the Final Office Action, is *prima facie* improper because the Non-Final Office Action provides an appropriate basis for combining WO '866 with either Venable '785 or Venable '812. See MPEP § 706.02(j): “To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the*

*art, to modify the reference or to combine reference teachings* (emphasis added) . . .

The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure* (emphasis added). *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

The Non-Final Office Action attempts to justify combining WO '866 with Venable '785 and Venable '812 based on the following conclusory statements:

**Conclusory Statements in Non-Final Office Action**

Alternatively, the secondary references disclose (note, in addition to the previously relied upon disclosure of Hubbard, paragraphs 0019 and particularly 0020, the latter which teaches applicant's preferred adhesive; WO '866, page 2, lines 22-25, page 3, lines 4-8, and Fig 2 and dry psa layer 12) the possibly missing element of a suitable solid, i.e. hot melt psa layer on the lower surface of the claimed laminate which is suitable for adhering the claimed covering material to a desired substrate, such as a suitable building structure. The references are believed to be clearly combinable, each taken from the roofing art which is clearly an example of a covering material, with the motivation being ease in application and use, together with the absence of harmful solvents or the like. Other parameters which are not expressly or inherently disclosed are again believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results (see Non-Final Office Action, p. 4)

The above Conclusory Statements fail to properly to identify any text in WO '866, Venable '785, Venable '812 or any other reference that would provide any proper motivation for combining WO '866 with either Venable '785 or Venable '812. As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), "[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness" (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with

another)).

Furthermore, as noted by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (see also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”)).

With respect to the combination of WO ‘866 with Venable ‘785, the Non-Final Office Action not only fails to identify any text in Venable ‘785 that would suggest that a person of ordinary skill in the art reading Venable ‘785 should read WO ‘866, but also fails to identify any portion of WO ‘866 that suggests that a person skilled in the art reading WO ‘866 should look at Venable ‘785. Similarly, with respect to the combination of WO ‘866 with Venable ‘812, the Non-Final Office Action not only fails to identify any text in Venable ‘812 that would suggest that a person of ordinary skill in the art reading Venable ‘812 should read WO ‘866, but also fails to identify any portion of WO ‘866 that suggests that a person skilled in the art reading WO ‘866 should look at Venable ‘812. Because the Non-Final Office Action has failed to articulate a proper basis for combining WO ‘866 with either Venable ‘785 or Venable ‘812, the combination of WO ‘866 with Venable ‘785 and the combination of WO ‘866 with Venable ‘812 are both *prima facie* improper, especially in view of the cited case law and MPEP § 706.02(j). Therefore, the rejection of Claims 1-20 over these improper combination of references is also *prima facie* improper.

ii. The combination of WO ‘866 with either Venable ‘785 or Venable ‘812 is *prima facie* improper, the combination is based on improper hindsight.

Because no proper support in the references has been identified for the combination of WO ‘866 with Venable ‘785 or with Venable ‘812, it must also be assumed that the Non-Final Office Action is improperly relying on Appellant’s own

disclosure as a basis for combining WO '866 with Venable '785 and with Venable '812. Effectively, the combination of WO '866 with Venable '785 set forth in the Non-Final Office Action presupposes the combination of WO '866 with Venable '785 and then provides a hindsight justification, found nowhere in the references, for this combination. Similarly, the combination of WO '866 with Venable '812 set forth in the Non-Final Office Action presupposes the combination of WO '866 with Venable '812 and then provides a hindsight justification, found nowhere in the references, for this combination. These hindsight justifications are contrary to controlling Federal Circuit precedent in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.*, 72 USQP2d 1333, 1336 (Fed. Cir 2004) that "Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 [42 USPQ2d 1378] (Fed. Cir. 1997) ("However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.")".

In addition, the Non-Final Office Action, in arguing that a person of ordinary skill in the art reading only Venable '785 would look at WO '866 only cites sections of WO '866 (see the Conclusory Statements quoted above). By only citing sections of WO '866, the Non-Final Office Action, once again, presupposes that the person of ordinary skill in the art has improperly relied on the Appellant's disclosure to combine WO '866 with Venable '785, rather than looking at what WO '866 teaches or suggests in the absence of the Appellant's disclosure. Such hindsight exemplified by the Non-Final Office Action makes the rejection of Claims 1-20 over the combination of WO '866 and Venable '785 *prima facie* improper.

Similarly, the Non-Final Office Action, in arguing that a person of ordinary skill in the art reading only Venable '812 would look at WO '866 only cites sections of WO '866 (see the Conclusory Statements quoted above). By only citing sections of WO '866, the Non-Final Office Action, once again, presupposes that the person of ordinary skill in the art has improperly relied on the Appellants' disclosure to combine

WO '866 with Venable '812, rather than looking at what WO '866 teaches or suggests in the absence of the Appellants' disclosure. Such hindsight exemplified by the Non-Final Office Action also makes the rejection of Claims 1-20 over the combination of WO '866 and Venable '812 *prima facie* improper for the reasons discussed above.

f. **The Comments in Section 3 of the Final Office Action Fail to Remedy Any of the Deficiencies of the Rejection of Claims 1-20 Over Either Venable '785 or Venable '812 in View of WO '866 Set Forth in the Non-Final Office Action.**

i. **Final Office Action fails to comply with MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2).**

The Final Office Action, which affirms the *prima facie* improper rejection and reasoning of the Non-Final Office Action fails to even address the fact that the rejection Claims 1-20 over Venable '785 or Venable '812 in view of WO '866 set forth in the Non-Final Office Action fails to comply with the requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2), as discussed above in Sections B(4)(a), B(4)(b), B(4)(c) and B(4)(d) of the present Brief and discussed previously in Applicant's December Amendment. Accordingly, the Final Office Action also fails to comply with the requirements of MPEP § 706.02(j) and 37 C.F.R. § 1.104(c)(2). Therefore, the rejection of Claims 1-20 over Venable '785 or Venable '812 in view of WO '866 is *prima facie* improper for at least this reason.

ii. **Final Office Action fails to provide a proper basis for combining WO '866 with either Venable '785 or Venable '812.**

Like the Non-Final Office Action, the Final Office Action also fails to articulate a proper basis for combining WO '866 with either Venable '785 or Venable '812 that complies with MPEP § 706.02(j) and the appropriate case law cited in

Section B(4)(e)(i) above. The Final Office Action attempts to justify combining WO '866 with Venable '785 and Venable '812 based on the following conclusory statements:

**Conclusory Statements in Final Office Action**

Note that all of the references (which are all taken from essentially the same art) at least briefly mention process difficulties associated with the application of flexible membranes to desired substrates such as roofing, etc (e.g. Venable '812, Col 1, lines 7-45; Venable '785, Col 1, line 17-Col 2, line 5, and WO '866, page 1, line 5-page 3, line 24, particularly page 3, lines 14-24). Additionally, the Examiner believes that these and related process of making difficulties are general knowledge within the art, as evidenced by these three citations, which when combined in the manner indicated, it is respectfully submitted, clearly overcome any allegations of hindsight such as applicant has made. Note also that WO '866 (page 1, lines 11-15, page 2, lines 22-25, page 3, lines 4-8, and FIG 2 as described particularly at page 5, lines 28-30) clearly discloses outer layer(s) of dry adhesives used in the same manner as the outer adhesive layers in applicant's claimed structures. Accordingly, it is respectfully submitted that there is more than ample motivation for one of ordinary skill to combine the references in the manner set forth by the Examiner and thereby either form, or clearly render obvious the claimed article and process inventions (see Final Office Action, p. 3)

However, the above Conclusory Statements fail to properly to identify any text in WO '866, Venable '785, Venable '812 or any other reference that would provide any proper motivation for combining WO '866 with either Venable '785 or Venable '812. With respect to the combination of WO '866 with Venable '785, the Final Office Action not only fails to identify any text in Venable '785 that would suggest that a person of ordinary skill in the art reading Venable '785 should read WO '866, but also fails to identify any portion of WO '866 that suggests that a person skilled in the art reading WO '866 should look at Venable '785.

Similarly, with respect to the combination of WO '866 with Venable '812, the Final Office Action not only fails to identify any text in Venable '812 that would suggest that a person of ordinary skill in the art reading Venable '812 should read WO '866, but also fails to identify any portion of WO '866 that suggests that a person

skilled in the art reading WO '866 should look at Venable '812. Because the Final Office Action has failed to articulate a proper basis for combining WO '866 with either Venable '785 or Venable '812, the rejection of Claims 1-20 over the combination of WO '866 with Venable '785 and the rejection of Claims 1-20 over the combination of WO '866 with Venable '812 are both *prima facie* improper, especially in view of MPEP § 706.02(j) and the appropriate case law cited in Section B(4)(e)(i) above.

In addition, Applicant does not understand the points that the Final Office Action is attempting to make in the above-cited conclusory statements. The Final Office Action appears to argue that any reference that describes, even briefly, process difficulties with application of flexible substrates can be combined, whether or not there is any suggestion or motivation in the references for making the combination. The Final Office Action fails to state why the mere fact that the references all mention process difficulties, provides a suggestion or motivation to combine the references. The Final Office Action also alleges that the cited references "when combined in the manner indicated [in the Non-Final Office Action]. . . clearly overcome any allegations of hindsight." However, for at least the reasons discussed above in Section B(4)(e)(ii) of this Brief, the Non-Final Office Action relies on improper hindsight to combine the cited references. Therefore, the Final Office Action appears to be arguing that using hindsight reasoning to combine references overcomes any allegations that the Non-Final Office Action and Final Office Action have used hindsight reasoning to combine references! For at least the above reasons, the comments in Section 3 of the Final Office Action appear to totally irrelevant to the question of whether there is proper motivation for combining the cited references.

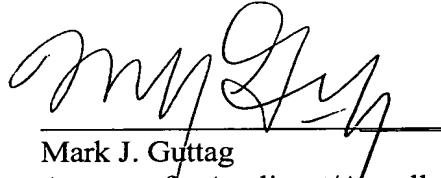
For at least the above reasons, the Comments in Section 3 of the Final Office Action Fail to Remedy Any of the Deficiencies of the Rejection of Claims 1-20 Over Either Venable '785 or Venable '812 in View of WO '866 Set Forth in the Non-Final Office Action.

### **SUMMARY OF ARGUMENT AND RELIEF REQUESTED**

For at least the reasons discussed above, the rejection of Claims 1-20 under 35 U.S.C. § 112, second paragraph, is *prima facie* improper and should be withdrawn. Also, for at least the reasons discussed above, the rejection of Claims 1-20 under 35 U.S.C. § 103(a) over either Venable '785 or Venable '812, each taken in view of WO' 866, is *prima facie* improper and should be withdrawn.

Accordingly, Appellants respectfully request the Honorable Board of Appeals and Interferences to reverse the Examiner's rejections of Claims 1-20 and remand with directions to allow the present application to issue with currently pending Claims 1-20.

Respectfully submitted,



\_\_\_\_\_  
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## CLAIM APPENDIX

1. A covering product comprising:  
a membrane comprising a thermoplastic; a fabric layer attached to a lower side of said membrane, said fabric layer being comprised of a fabric material; and  
an adhesive covering at least a portion of a lower side of said fabric layer for allowing said covering product to be adhered to a building structure, wherein said adhesive is pre-applied to said fabric layer prior to adhering said covering product on the building structure.
2. The product of claim 1, wherein said building structure is a roof deck.
3. The product of claim 1, wherein said lower side of said membrane includes an exposed section that is not covered by said fabric layer.
4. The product of claim 1, wherein said adhesive comprises a styrene-ethylene-butylene styrene adhesive.
5. The product of claim 1, further comprising a release liner covering said lower side of said fabric layer at least in the region where said adhesive is present.
6. The product of claim 5, wherein said release liner covers substantially all of a lower side of said product.
7. The product of claim 1, wherein said thermoplastic comprises polyvinyl chloride.
8. The product of claim 1, wherein said fabric material comprises a non-woven material.
9. The product of claim 1, wherein said membrane includes a UV absorber and/or a UV screener.
10. The product of claim 1, wherein said membrane includes a fire retardant.

11. A method for mounting at least one membrane on a building structure comprising the following steps:

(a) providing a building structure; and

(b) adhering a first membrane on the building structure, said first membrane being adhered to the building structure by a first adhesive coated on a lower side of a first fabric layer bonded to the first membrane and said first fabric layer being comprised of a first fabric material, wherein said first membrane is comprised of a thermoplastic and wherein said first adhesive is pre-applied to said first fabric layer prior to adhering said first membrane on the building structure.

12. The method of claim 11, further comprising the following steps:

(c) adhering a second membrane on the building structure, said second membrane being adhered to the building structure by a second adhesive coated on a lower side of a second fabric layer bonded to the second membrane and said second fabric layer being comprised of a second fabric material; and

(d) overlapping an exposed section of said second membrane over an overlapped section of an upper side of said first membrane, said exposed section being uncovered by said second fabric layer; and

(e) joining said exposed section to said overlapped section, wherein said second membrane is comprised of thermoplastic and wherein said second adhesive is pre-applied to said second fabric layer prior to adhering said second membrane on the building structure.

13. The method of claim 12, wherein step (e) comprises hot air welding said exposed section to said overlapped section.

14. The method of claim 11, wherein said building structure is a roof deck.

15. The method of claim 11, wherein said first adhesive comprises a styrene-ethylene-butylene styrene adhesive.

16. The method of claim 11, wherein said method comprises removing a release liner covering said first adhesive from said first adhesive prior to step (b).
17. The method of claim 11, wherein said thermoplastic comprises polyvinyl chloride.
18. The method of claim 11, wherein said first fabric material comprises a non-woven material.
19. The method of claim 11, wherein said first membrane includes a UV absorber and/or a UV screener.
20. The method of claim 11, wherein said first membrane includes a fire retardant.

## **EVIDENCE APPENDIX**

There is no evidence of record other than the references cited by the Examiner during the prosecution of the present application.

**RELATED PROCEEDINGS APPENDIX**

There have been no decisions rendered by a court or the Board in any proceedings related to this appeal.